

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 10-22, 47, 56-67, and 74-77 are pending in the application, with claims 10-12, 18, 20 and 47 being the independent claims. Claims 68-73 have been cancelled without prejudice to or disclaimer of the subject matter therein. Claims 10-12, 13, 18, 20, 47 and 74 have been amended. New claims 76 and 77 have been added. No new matter is added by way of these amendments, and their entry is respectfully requested. Support for the amendment to claims 10-12, 18, 20 and 47 may be found in the specification at page 10, lines 12-19, which state that “The compounds and methods of the invention...do not require labeling of oligonucleotides with two different compounds (like FRET-based methods)...” FRET is defined in the specification at page 3, lines 4-14. Support for new claims 76 and 77 may be found in the specification at page 64, lines 2 and 23, respectively. Claim 13 has been amended to depend on Claims 10, 11 and 12.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections.

I. *Claim Rejections Under 35 U.S.C. § 112, First Paragraph*

Claims 10-22, 47 and 56-67 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. (Office Action, page 2.) Specifically, the phrase "wherein said detectable change in an observable property is not the result of a transfer of energy between two different compounds attached to said one or more oligonucleotides" was characterized as new matter. (Office Action, page 3.). Applicants disagree with this characterization, however, in an earnest effort to advance prosecution of the application, Claims 10-12, 18, 20, and 47 have been amended, and no longer recite the phrase characterized as new matter. Applicants therefore request that the rejection under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

II. Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 10-22, 47 and 56-67 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. (Office Action, page 4.) Specifically, the phrase "not the result of a transfer of energy between two different compounds" was characterized as indefinite. Applicants disagree with this characterization, however, in an earnest effort to advance prosecution of the application, Claims 10-12, 18, 20, and 47 have been amended, and no longer recite the phrase characterized as indefinite. Applicants therefore request that the rejection under 35 U.S.C. § 112, second paragraph, be reconsidered and withdrawn.

III. *Claim Rejections Under 35 U.S.C. § 102*

A. *Livak*

Claims 68-70, 72 and 73 were rejected under 35 U.S.C. § 102(b) as being anticipated by Livak *et al.*, WO 96/15270 ("Livak"). (Office Action, page 5.) Although Applicants disagree with this rejection, claims 68-70, 72 and 73 have been cancelled, thereby rendering the rejection moot.

B. *Nazarenko*

Claim 71 was rejected under 35 U.S.C. § 102(b) as being anticipated by Nazarenko *et al.*, *Nucl. Acids Res.* 25:2516-2521 (1997) ("Nazarenko"). (Office Action, page 7.) Although Applicants disagree with this rejection, claim 71 has been cancelled, thereby rendering the rejection moot.

IV. *Claim Rejections Under 35 U.S.C. § 103*

A. *Heller in View of Nazarenko*

Claims 68-75 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Heller *et al.*, U.S. Patent No. 5,565,322 ("Heller") in view of Nazarenko. (Office Action, page 8.) Although Applicants disagree with this rejection, claims 68-73 have been cancelled. In addition, claims 74 and 75 have been amended to depend only from claims 10-12, 18, 20 and 47, which were not rejected under § 103. Thus, this rejection is moot.

B. Nazarenko

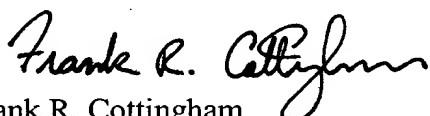
Claim 71 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nazarenko. (Office Action, page 11.) Although Applicants disagree with this rejection, claim 71 has been cancelled, thereby rendering the rejection moot.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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